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1 UNITED STATES PATENT AND TRADEMARK OFFICE

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3
4 BEFORE THE BOARD OF PATENT APPEALS
5 AND INTERFERENCES
6

7
8 Ex parte HIDENARI TANAKA, HIROSHI MURAKAMI,
9 TATUHIKO HAYASHI, YOSHIHARU YAMADA, KAZUTOSHI TAKASE,
10 TETSUKAZU NAKAMURA, and AKIRA ISHIHARA
11

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13 Appeal 2007-2731
14 Application 09/209,454
15 Technology Center 3600
16

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18 Decided: January 18, 2008
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21 Before TERRY J. OWENS, MURRIEL E. CRAWFORD, and
22 ANTON W. FETTING, Administrative Patent Judges.
23 FETTING, Administrative Patent Judge.

24 DECISION ON APPEAL

25 STATEMENT OF CASE

26 Hidenari Tanaka, Hiroshi Murakami, Tatuhiiko Hayashi, Yoshiharu Yamada,
27 Kazutoshi Takase, Tetsukazu Nakamura, and Akira Ishihara (Appellants) seek
28 review under 35 U.S.C. § 134 of a final rejection of claims 17-22, the only claims
29 pending in the application on appeal.

30 We have jurisdiction over the appeal pursuant to 35 U.S.C. § 6(b) (2002).

31
32 We AFFIRM.

1 The Appellants invented a system for selling contact lenses using information
2 processing apparatus connected through a communication network. (Specification
3 1:4-6).

4 An understanding of the invention can be derived from a reading of exemplary
5 claim 17, which is reproduced below [bracketed matter and some paragraphing
6 added].

7 17. A method of selling prescription contact lenses comprising:

8 [1] transferring contact lens customer

9 identification,

10 address, and

11 diagnostic data

12 pertaining to a respective contact lens customer

13 from a plurality of second group information processing

14 apparatus located at respective facilities of contact lens

15 prescribers,

16 the plurality of second group information processing

17 apparatus being connected through a communication

18 network to a first group information processing apparatus

19 located at a facility of a contact lens seller,

20 to the first group information processing apparatus through the

21 communication network;

22 [2] assigning a registration number to the customer and

23 storing the registration number assigned

24 in relationship with the customer identification and diagnostic data

25 transferred to the contact lens seller;

26 [3] providing

27 the registration number assigned and

28 selling agent data

1 for a selling agent closest in geographical relation to the
2 customer based on the contact lens customer address
3 data,
4 from the contact lens seller to the contact lens customer,
5 through the communication network;
6 [4] delivering a contact lens from the selling agent to the contact lens
7 customer;
8 [5] transferring delivery data from the selling agent to the contact lens
9 seller through the communication network;
10 [6] writing,
11 through both the first group information processing apparatus
12 and
13 the plurality of second group information processing apparatus,
14 on respective portable recording media for each contact lens
15 customer,
16 data, including the corresponding registration number, and
17 issuing the corresponding portable recording medium to the
18 respective customer,
19 so the contact-lens customer can select any contact lens
20 prescriber, and
21 change between any contact lens prescriber,
22 having access to one of the second group information
23 processing apparatus and the communication network
24 without changing the contact lens seller;
25 [7] determining an exchange time for exchanging the contact lens,
26 based upon date of issuance of the contact lens and
27 characteristics of the contact lens,
28 by the first group information processing apparatus of the
29 contact lens seller,
30 using data recorded on the portable recording medium of the
31 corresponding contact lens customer to whom a contact lens has
32 been issued by the contact lens seller through the selling agent;
33 and

1 [8] notifying a contact lens customer to whom a contact lens was
2 issued of the exchange time.

3 This appeal arises from the Examiner's Final Rejection, mailed October 24,
42004. The Appellants filed an Appeal Brief in support of the appeal on March 14,
52005. An Examiner's Answer to the Appeal Brief was mailed on September 22,
62006. A Reply Brief was filed on August 4, 2005.

7 PRIOR ART

8 The Examiner relies upon the following prior art:

Pauly	US 4,958,280	Sep. 18, 1990
Dawson, Jr.	US 5,623,242	Apr. 22, 1997
Eberhardt	US 5,659, 741	Aug. 19, 1997
Fay	US 5,983,201	Nov. 9, 1999

9Thomas M. Steltzer, "Cashing in on quicker delivery times," Chilton's
10Distribution, v.90, n.6, p. 34(3), June 1991.

11 REJECTIONS

12 Claims 17, 19, and 21 stand rejected under 35 U.S.C. § 103(a) as unpatentable
13over Pauly, Fay, and Eberhardt.

14 Claim 18 stands rejected under 35 U.S.C. § 103(a) as unpatentable over Pauly,
15Fay, Eberhardt, and Dawson.

16 Claims 20 and 22 stand rejected under 35 U.S.C. § 103(a) as unpatentable over
17Pauly, Fay, Eberhardt, and Steltzer.

18 ISSUES

19 The issues pertinent to this appeal are:

- Whether the Appellants have sustained their burden of showing that the Examiner erred in rejecting claims 17, 19, and 21 under 35 U.S.C. § 103(a) as unpatentable over Pauly, Fay, and Eberhardt.
 - Whether the Appellants have sustained their burden of showing that the Examiner erred in rejecting claim 18 under 35 U.S.C. § 103(a) as unpatentable over Pauly, Fay, Eberhardt, and Dawson.
 - Whether the Appellants have sustained their burden of showing that the Examiner erred in rejecting claims 20 and 22 under 35 U.S.C. § 103(a) as unpatentable over Pauly, Fay, Eberhardt, and Steltzer.
- The pertinent issues turn on whether Pauly or Fay would have suggested delivering contact lenses from a selling agent separate from the original prescriber.

FACTS PERTINENT TO THE ISSUES

The following enumerated Findings of Fact (FF) are believed to be supported by a preponderance of the evidence.

Pauly

1. Pauly is directed toward alternative ordering methods for eye care professionals. The methods include automated order entry through personal computers at the professional's office location, communicating through data links with central computers at the supplier, and direct telephone calls.
2. Pauly uses the term "doctor" to refer to a prescribing party, which may be an ophthalmologist, optometrist, an optician, or a commercial entity involved in the business of contact lens prescriptions (Pauly 3:44-50).

1 3. There may be many such prescribing parties connected to Pauly's
2 system by personal computers (Pauly 4:51-54)

3 Fay

4 4. Fay is directed toward the field of eyeglasses. Fay's device assists in
5 fitting frames for eyeglasses to a customer and displaying to the
6 customer how the customer would appear wearing the fitted eyeglass
7 frames (Fay 1:9-14).

8 5. Fay's frames may be fitted with prescription or plain lenses (Fay 2:59-
9 60).

10 6. Fay's device may be located on the premises of an optician or an
11 optometrist (Fay 5:29-31).

12 7. Fay's customer can direct that the frames be obtained via a selected
13 optical retail store. Fay then presents a database of optical retail
14 locations to the customer. Once the order is complete, the relevant order
15 information concerning the frame and prescriptive lens information, and
16 customer information is sent to the selected optical retail location for
17 processing of the order. The customer can then complete the transaction
18 at the selected optical retail location.

1 Eberhardt

2 8. Eberhardt is directed toward storing medical history on a storage device
3 that a patient can carry on its person for aggregating vast amounts of
4 medical history (Eberhardt 1:9-60).

5 PRINCIPLES OF LAW

6Claim Construction

7 During examination of a patent application, pending claims are given
8their broadest reasonable construction consistent with the specification. *In*
9*re Prater*, 415 F.2d 1393, 1404-05 (CCPA 1969); *In re Am. Acad. of Sci.*
10*Tech Ctr.*, 367 F.3d 1359, 1364, (Fed. Cir. 2004).

11 Limitations appearing in the Specification but not recited in the claim are not
12read into the claim. *E-Pass Techs., Inc. v. 3Com Corp.*, 343 F.3d 1364, 1369 (Fed.
13Cir. 2003) (claims must be interpreted “in view of the specification” without
14importing limitations from the specification into the claims unnecessarily)

15 Although a patent applicant is entitled to be his or her own lexicographer of
16patent claim terms, in ex parte prosecution it must be within limits. *In re Corr*, 347
17F.2d 578, 580 (CCPA 1965). The applicant must do so by placing such definitions
18in the Specification with sufficient clarity to provide a person of ordinary skill in
19the art with clear and precise notice of the meaning that is to be construed. See
20also *In re Paulsen*, 30 F.3d 1475, 1480 (Fed. Cir. 1994)(although an inventor is
21free to define the specific terms used to describe the invention, this must be done
22with reasonable clarity, deliberateness, and precision; where an inventor chooses to
23give terms uncommon meanings, the inventor must set out any uncommon

1definition in some manner within the patent disclosure so as to give one of
2ordinary skill in the art notice of the change).

3Obviousness

4 A claimed invention is unpatentable if the differences between it and the
5prior art are “such that the subject matter as a whole would have been obvious at
6the time the invention was made to a person having ordinary skill in the art.” 35
7U.S.C. § 103(a) (2000); *KSR Int’l v. Teleflex Inc.*, 127 S.Ct. 1727, 1734 (2007);
8*Graham v. John Deere Co.*, 383 U.S. 1, 13-14 (1966).

9 In *Graham*, the Court held that that the obviousness analysis is bottomed on
10several basic factual inquiries: “[(1)] the scope and content of the prior art are to be
11determined; [(2)] differences between the prior art and the claims at issue are to be
12ascertained; and [(3)] the level of ordinary skill in the pertinent art resolved.” 383
13U.S. at 17. See also *KSR Int’l v. Teleflex Inc.*, 127 S.Ct. at 1734. “The
14combination of familiar elements according to known methods is likely to be
15obvious when it does no more than yield predictable results.” *KSR*, at 1739.

16 “When a work is available in one field of endeavor, design incentives and
17other market forces can prompt variations of it, either in the same field or [in] a
18different one. If a person of ordinary skill in the art can implement a predictable
19variation, § 103 likely bars its patentability.” *Id.* at 1740.

20 “For the same reason, if a technique has been used to improve one device,
21and a person of ordinary skill in the art would recognize that it would improve
22similar devices in the same way, using the technique is obvious unless its actual
23application is beyond his or her skill.” *Id.*

1 “Under the correct analysis, any need or problem known in the field of
2endeavor at the time of invention and addressed by the patent can provide a reason
3for combining the elements in the manner claimed.” *Id.* at 1742.

4 Automation of a Known Process

5 It is generally obvious to automate a known manual procedure or mechanical
6device. Our reviewing court stated in *Leapfrog Enterprises, Inc. v. Fisher-Price,*
7*Inc.*, 485 F.3d 1157 (Fed. Cir. 2007) that one of ordinary skill in the art would have
8found it obvious to combine an old electromechanical device with electronic
9circuitry “to update it using modern electronic components in order to gain the
10commonly understood benefits of such adaptation, such as decreased size,
11increased reliability, simplified operation, and reduced cost. . . . The combination
12is thus the adaptation of an old idea or invention . . . using newer technology that is
13commonly available and understood in the art.” *Id.* at 1163.

14 ANALYSIS

15 *Claims 17, 19, and 21 rejected under 35 U.S.C. § 103(a) as unpatentable over*
16 *Pauly, Fay, and Eberhardt.*

17 The Appellants argue claims 17 and 21 as a group.

18 Accordingly, we select claim 17 as representative of the group.

1937 C.F.R. § 41.37(c)(1)(vii)(2006).

20 The Examiner found that Pauly describes all of the contact lens data and
21transactions of claim 17, that Fay is evidence that a purchaser of prescription lens
22might prefer to accept delivery from a retail optical shop to show the sales agent
23activities of claim 17, and that Eberhardt described a portable recording medium as
24cited in claim 17 (Answer 3-8).

1 The Appellants contend that (1) Pauly doesn't show the portable recording
2medium in claim 17 (Br. 6: Top ¶ and first half of first full ¶); (2) claim 17
3establishes loyalty between the customer and seller, whereas Pauly establishes
4loyalty between customer and prescriber (Br. 6: Bottom half of first full ¶ and
5bottom ¶); (3) claim 17 requires that the nearest selling agent deliver the lenses,
6whereas Pauly does not (Br. 7: First full ¶); (4) Fay is inapplicable because Fay
7describes selling eyeglass frames and not contact lenses, eliminating a need for an
8optician (Br. 7: Second full ¶); (5) one of ordinary skill would not consult Fay
9because Fay does not relate to contact lenses and Fay's device is for showing a
10customer's facial appearance which contact lenses do not alter (Br. 7: Third full ¶ -
118 First full ¶); and (6) neither Pauly nor Fay describe a portable medium (Br. 8:
12Second full ¶).

13Appellants' arguments (1) and (6) that neither Pauly nor Fay show the portable
14recording medium in claim 17.

15 The Appellants' argument overlooks Eberhardt as applied prior art. We find,
16as the Examiner found, that Eberhardt describes providing a portable recording
17medium for holding patient data (FF). The Appellants acknowledge that
18Eberhardt describes the portable medium, but their only argument as to Eberhardt
19is that even with Eberhardt, there is no basis for modifying Pauly with Fay (Br.
208:Second full ¶). We find the argument that neither Pauly nor Fay show that which
21Eberhardt is applied to describe to be unpersuasive in view of Eberhardt's
22uncontested description.

23Appellants' argument (2) that claim 17 establishes loyalty between the customer
24and seller, whereas Pauly establishes loyalty between customer and prescriber.

25 The Appellants argue that the customer establishing loyalty with the selling
26agent in claim 17 is a feature unrecognized by the Examiner (Br. 6:First full ¶).

1 We find that this argument is not commensurate with the scope of claim 17,
2which is silent as to loyalty. To the extent the Appellants are implying that such
3loyalty is a secondary consideration for evidence of non-obviousness, the
4Appellants have not made a connection between such loyalty and any evidence of
5non-obviousness such as an unexpected benefit of the claimed invention.

6Appellants' argument (3) that claim 17 requires that the nearest selling agent
7deliver the lenses, whereas Pauly does not.

8 The Appellants argue that it is the party the customer goes to for picking up the
9lenses from that establishes the loyalty in the prior argument, and claim 17 requires
10this be a selling agent, while Pauly describes this party as the prescriber (Br.
116:Second full ¶ - 7:First full ¶).

12 Again, claim 17 is silent as to loyalty. Claim 17 does recite that it is the selling
13agent that delivers the lenses to the customer in step [4]. While, as the Appellants
14argue, it is Pauly's prescriber who delivers the lenses, Pauly describes the
15prescriber as an opthamologist, optometrist, optician, or a commercial entity
16involved in contact lens prescriptions (FF). Pauly also shows that multiple such
17prescribers are connected to its system (FF). Thus, Pauly does not preclude
18having one prescriber initially and another for delivery.

19 Fay suggests that a prescription lens patient may desire to have just such a
20separation between the initial prescriber and the delivery agent; common sense
21suggests this would be for subsequent convenience in delivery. Fay describes its
22device as being possibly located at a prescriber, such as an optician or optometrist
23(FF). Common sense again suggests this is because the lenses in Fay's eyeglass
24frames may be prescription lenses (FF). Fay describes an alternate delivery
25location from where its device was used, such as an optical retail location (FF).

1 Fay describes its device as providing a list of locations of such optical retail
2 locations, suggesting that choice of location would be a reason the customer would
3 prefer such a location (FF). Such a list, by its encompassing scope, would include
4 within it the location closest in geographical relation to the customer as recited in
5 claim step [3]. One of ordinary skill, and even common sense, would recognize
6 that the most likely such retail location a customer would select, based on a
7 purchasing convenience selection criterion, would be that location closest to the
8 customer. “Often, it will be necessary for a court to look to . . . the effects of
9 demands known to the design community or present in the marketplace; and the
10 background knowledge possessed by a person having ordinary skill in the art, all in
11 order to determine whether there was an apparent reason to combine the known
12 elements in the fashion claimed by the patent at issue.” KSR, id. at 1740–41.

13 Thus, although Pauly does not describe delivery from a selling agent, Fay
14 describes delivery of optical lenses from a selling agent in the form of an optical
15 retail location separate from the prescriber, and suggests that an optical lens
16 purchaser would desire to select such a location as its sales agent separate from the
17 prescriber. Common sense suggests this would be for the sake of convenience and
18 therefore the closest such location would likely be selected as the most convenient.
19 Therefore, we find this argument unpersuasive.

20 Appellants’ argument (4) that Fay is inapplicable because Fay describes selling
21 eyeglass frames and not contact lenses, eliminating a need for an optician.

22 The Appellants appear to be arguing that Fay needs no optician (Br. 7:Second
23 full ¶). The Appellants overlook Fay’s description of the possible location for its
24 device as being at just such an optician, or even optometrist (FF). This coincides
25 with Pauly’s description of its prescribers (FF). For that matter, Fay’s retail
26 optical location may coincide with Pauly’s commercial entity involved in the

1business of contact lens prescriptions (FF). Since all of these locations may be
2connected to Pauly's system (FF), and Fay suggests that a customer may choose a
3sales agent for delivery separate from a prescriber (FF), Fay provides the
4motivation for allowing a customer to select a selling agent tied in to Pauly's
5system separate from Pauly's prescriber. Therefore, we find this argument
6unpersuasive.

7Appellants' argument (5) that one of ordinary skill would not consult Fay because
8Fay does not relate to contact lenses and Fay's device is for showing a customer's
9facial appearance which contact lenses do not alter.

10 We take this argument to mean that one of ordinary skill would not combine
11Pauly and Fay (Br. 7:Third full ¶ - 8:First full ¶). This argument is echoed by the
12Appellants subsequently in its argument concerning Eberhardt's portable media we
13analyzed, *supra*.

14 As we noted above, market forces may dictate design. See KSR, *id*. Fay
15presents evidence of marketplace demand by customers of prescriptive lenses for
16delivery of lenses by a party separate from the original prescriber (FF). It is not
17necessary that one of ordinary skill would have looked to incorporating Fay's
18machine into Pauly's design for Fay's evidence of this market demand to be
19pertinent to Pauly. It is sufficient that Fay is descriptive of at least part of the
20market that Pauly must address, which the commonality of the optometrist and
21optician locations in both Pauly and Fay show to be the case. Thus, we find that
22Fay is at least probative of the market demand that users of Pauly's system would
23face and therefore the Appellants' arguments are unpersuasive.

24 The Appellants separately argue claim 19. Claim 19 recites offering new
25contact lenses to the contact lens customer in exchange for old contact lenses at
26irregular times, upon any of loss of transparency of the contact lenses, breakage of

1the contact lenses, and scratching or soiling of the contact lenses, and a monthly
2payment by the contact lens customer.

3 The Examiner found that a customer would replace contact lenses with Pauly's
4process when lenses were broken or scratched and this would occur irregularly
5(Answer 8-9). The Appellants argue the Examiner has provided no evidence (Br.
68:Last ¶).

7 Although it appears the Appellants attempted to draft an insurance type
8transaction in claim 19, it is actually broader than that. As the Examiner found, it
9only requires that the seller offer replacements for broken, scratched, transparency
10lost, or soiled lens for monthly payment. The claim makes no restriction on
11whether the payment is prospective or retrospective with respect to the loss. As the
12Examiner found, subsequent payment would correspond to simply purchasing
13another lens or set of lenses. We find that monthly payments are a common cycle
14of paying for relatively costly items, such as contact lenses. Thus, we find the
15Appellants argument unpersuasive.

16 The Appellants have not sustained their burden of showing that the Examiner
17erred in rejecting claims 17, 19, and 21 under 35 U.S.C. § 103(a) as unpatentable
18over Pauly, Fay, and Eberhardt.

19 *Claim 18 rejected under 35 U.S.C. § 103(a) as unpatentable over Pauly, Fay,*
20 *Eberhardt, and Dawson.*

21 The Appellants have relied on their arguments regarding claim 17 and have not
22separately argued the limitations of claim 18. We therefore find the Appellants
23have not sustained their burden of showing that the Examiner erred in rejecting
24claim 18 under 35 U.S.C. § 103(a) as unpatentable over Pauly, Fay, Eberhardt, and
25Dawson for the same reasons we found supra.

1 *Claims 20 and 22 rejected under 35 U.S.C. § 103(a) as unpatentable over*
2 *Pauly, Fay, Eberhardt, and Steltzer.*

3 The Appellants have relied on their arguments regarding claim 17 and have not
4separately argued the limitations of claims 20 and 22. We therefore find the
5Appellants have not sustained their burden of showing that the Examiner erred in
6rejecting claim claims 20 and 22 under 35 U.S.C. § 103(a) as unpatentable over
7Pauly, Fay, Eberhardt, and Steltzer for the same reasons we found supra.

8 CONCLUSIONS OF LAW

9 The Appellants have not sustained their burden of showing that the Examiner
10erred in rejecting claims 17-22 under 35 U.S.C. § 103(a) as unpatentable over the
11prior art.

12 On this record, the Appellants are not entitled to a patent containing claims 17-
1322.

14 REMARKS

15 Should the Appellants amend claim 19 to more closely recite a contact lens
16insurance transaction, the Examiner should consider the notoriety of such
17insurance and the relevance of insurance companies, such as RLI Corp, that began
18offering such insurance in the early 1960's.¹

50¹<http://my.rlicorp.com/about/history.asp>

1 DECISION

2 To summarize, our decision is as follows:

- 3 • The rejection of claims 17, 19, and 21 under 35 U.S.C. § 103(a) as
4 unpatentable over Pauly, Fay, and Eberhardt is sustained.
- 5 • The rejection of claim 18 under 35 U.S.C. § 103(a) as unpatentable over
6 Pauly, Fay, Eberhardt, and Dawson is sustained.
- 7 • The rejection of claims 20 and 22 under 35 U.S.C. § 103(a) as unpatentable
8 over Pauly, Fay, Eberhardt, and Steltzer is sustained.

9 No time period for taking any subsequent action in connection with this appeal
10 may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

11

12 AFFIRMED

13

14
15
16jlb

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